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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,500	03/12/2004	Daniel L. Holguin	AVP.P2418 A3	1729
23575	7590	05/04/2005	EXAMINER	
JOSEPH G CURATOLO, ESQ. CURATOLO SIDOTI CO. LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145			ZALUKAEVA, TATYANA	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/799,500

**Applicant(s)**

HOLGUIN ET AL.

**Examiner**

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/2004</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 8 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited in claim 3 "...impurities in the total amount of no more than about 3% contradicts the statement in claim 1 citing the positive amount of impurities of "at least 0.05%" "No more than about 3% also includes 05, i.e. the absence of such impurities. Claim 23 calls for cosmetic composition prepared by the method of claim 16, however, claim 16 calls for the method of making pressure sensitive adhesive. Correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1-4, 8, 9, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kliment et al (U.S. 3,784,540) in view of Kirk et al (U.S. 5,601,723).

Kliment discloses a method for preparing powdered poly 2-hydroxyethyl methacrylate in organic solvent (abstract, col.2, lines 36-41), the concentration of ethylene glycol dimethacrylate is 1% and can be up to 3% (col.3, lines 1-5), the polymerization is carried out in the presence of free readical initiator, such as those described in col.3, lines 40-52 in the amount of 0.05-1% by weight relative to monomer (col.3, lines 51,52). After polymerization is completed, the precipitation takes place, which is carried out at the temperature of 30C or above (col.2, lines 13-15). This reads on the step of "drying

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polymerization mixture", as per instant claim 1. After precipitation, the fine powder is formed (col.2, lines 39-41).

The disclosure of Klement differs from the instant claims in disclosing solution polymerization in organic solvent vs. water as per instant claims.

Kirk discloses an **aqueous polymerization process** for preparing a **water soluble polymer**. The process is performed at a pH of about 3 or less, This pH is maintained to keep a molecular weight of a resulting polymer is less than 30000 (see abstract).

Kirk discloses the steps of free radical polymerization substantially the same as claimed. Carboxyl free monomers are listed in col. 6, lines 4-20, among them 2-hydroxyethyl Methacrylate as a comonomer appears in line 9 of col. 6. Kirk appears to disclose commercial grade monomers that inherently contain the amount of impurities within the claimed range.

The need for eliminating toxic solvents from polymerization processes has long been known in the art. Accordingly, based on the similarity of processes of Kirk and Klement and on using a HEMA as a monomer, it would have been obvious to those skilled in the art to perform the process of Klement in water as taught in Kirk to eliminate the toxic solvents from the process and still preserve the solubility in organic solvents.

7. Claims 5-7, 10-12, 16-21, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kliment et al (U.S. 3,784,540) in view of Kirk et al (U.S. 5,601,723) and further in view of JP 62227682 or separately over Kliment et al (U.S. 3,784,540) in view of Kirk et al (U.S. 5,601,723) and further in view of JP 09241596.

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Klement and Kirk disclose the process of making polymer as instantly claimed. They do not disclose further stage of the process, wherein the obtained polymer is blended with polyalkylene glycol to obtain a pressure sensitive adhesive. Addition of polyethylene glycol to acrylate polymers in pressure sensitive adhesive is known in the art. The introduction of polyethylene glycol into PSA allows to prevent absorption of the component of the coating film. Thus JP'596 discloses a method of coating a substrate by forming a layer of a rubber base pressure-sensitive adhesive containing polyethylene glycol having a weight-average molecular weight of 100-7,000. The make of bonding is apt to leave on the sheet because the absorption preventive effect of the component of the coating film is insufficient when the weight-average molecular weight is outside the range of 100-7,000.

JP'682 discloses coating a substrate with pressure sensitive adhesive that comprises 100 parts by weight of acrylic ester copolymer, and 5-45 parts by weight polyethylene glycol with an average mole wt. of 180-1100. The acrylic ester copolymer is prepared by emulsion-polymerizing 60-99.8 parts by weight of (meth)acrylic ester (a), 0.2-10 parts by weight of polymerizable unsaturated carboxylic acid (b), and 0-39.8 parts by weight of a copolymerizable vinyl monomer.

Therefore, based on the well established utility of polyethylene glycol as an absorption preventive component in PSA, and because the polyethylene glycol has high water absorptive property, it would have been obvious to those skilled in the art to add the polyethylene glycol into the process of Klement and Kirk in order to make an adhesive useful for bonding in humid atmosphere, surfaces adhered with water, frost, ice, etc.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 22 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Klement.

Because of the nature of product-by process claims, the Examiner cannot ordinarily focus on the precise difference between the claimed product and the disclosed product.

It is then Applicants' burden to prove that an unobvious difference exists. See *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983).

See also footnote 11 O.G. Notice 1162 59-61, wherein a 35 USC 102/103 rejection is authorized in the case of product-by-process claims because the exact identity of the claimed product or the prior art product cannot be determined by the Examiner.

*In re Thorpe*, 227 USPQ 964 (CAFC 1985) the Examiner rejected product-by-process claims over a product, which although prepared in a different manner, appeared to be the same (prima facie) as the claimed product. *In re Brown*, 173 USPQ 685 (CCPA 1972), the Court of Customs and Patent Appeals (CCPA) explicitly approved the 102/103 rejection of a product-by-process claim over a reference which showed a product which appeared to be identical or only slightly different from the claimed product.

10. Other prior art references cited in PTOL-892 show the state of the art.

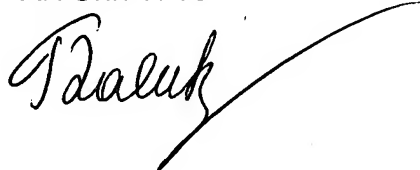
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'T. Zalukaeva', with a long, sweeping horizontal line extending to the right.

April 27, 2005